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JEFF J STAGGS
7474 E ARKANSAS AVE #8-10
DENVER , CO 80231

In re Application of
Jeff J. Staggs
Serial No.: 08/338,489
Filed: March 18, 1997 (acceptance date)
Attorney Docket No.:

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: PETITION DECISION
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This letter is in response to the renewed petition under 37 CFR 1.126 received June 16, 2000, again requesting refund of fees paid for excess claims.

A review of the file history as it applies to fees paid by applicant in this application is set forth in the previous petition decision. As stated therein, none of the fees paid were considered or found to have been paid in error. Merely because a claim has been withdrawn from consideration because of a restriction requirement does not mean that the claim is canceled or that fee credit for that claim is given or the fee therefor is refunded to applicant. Merely because a claim is withdrawn from consideration or examination does not mean it is not a pending claim. It is. It is not uncommon during prosecution of an application for a restriction requirement to be reconsidered and some or all non-elected or withdrawn claims to be rejoined and examined with the previously elected claims. This is based on successful argument of a restriction requirement where the requirement is revised or withdrawn entirely or it may be done at the discretion of the examiner because of other circumstances or fact patterns. If withdrawn claims were not considered "still pending claims", rejoinder could not be effected to the detriment of applicant.

As stated in the previous decision, the filing and extra claim fees paid by applicant upon initial filing of this application were properly calculated. That applicant later reduced the number of claims in response to the examiner's Office action has no bearing on the correctness of the fees paid at filing and does not entitle applicant to a refund of excess claim fees paid upon cancellation of non-examined claims since the fees were not, in fact, paid in error.

Applicant's contention on page 2, third and fourth paragraphs (*italics quote and following paragraph*) present a strained and incorrect interpretation of M.P.E.P. 607. The correct interpretation and the one the Office has used for many years is that a claim, whether examined or not, is a pending claim until canceled and applicant will be charged for such pending claim until it is canceled. When a claim is canceled the fee charged for that claim will be credited against any other pending claim, but will not be refunded. The addition of claims in excess of those originally filed without cancellation of an equivalent number of original claims will result in additional claim fee being required. The establishment of a fee schedule for examination of applications is directly mandated by statute which requires that the Office be fully fee funded. Thus fees are established

in expectation of performing services as will be appropriate to fully fund Office operations. The fees for each application are assessed without respect to consideration of any other related application. As examination of each application must be done individually, so must fees be similarly assessed.

With respect to the restriction requirement alleged to have been improper, It is noted that all claims are directed to methods of treating various conditions or diseases, such a lung diseases, cancel, psoriasis, fungal infections of various parts of the body, acne, etc. Each of these methods is mutually exclusive of the other methods claimed and may therefor be properly restricted in the international and/or national stage of prosecution irrespective. Failure to make a lack of unity determination in the international phase of examination does not preclude such a holding from being made in the national phase of examination.

It is noted that applicant submitted a revised specification after the Notice of Allowability and Notice of Allowance and Issue Fee Due were mailed. Since this substitute specification was not requested by the examiner it was not entered. This is general Office policy.

Applicants' petition is again **DENIED**.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230

John Doll 
Director, Technology Center 1600